

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Brown, et al.) Group Art Unit 2764
 Appl. No. : 09/213,138)
 Filed : December 16, 1998)
 For : SYSTEM AND METHOD FOR)
 BROWSING AND COMPARING)
 PRODUCTS)
 Examiner : Steven R. Wasylchak)
)
) I hereby certify that this correspondence and all
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) mail in an envelope addressed to: Assistant
) Commissioner for Patents, Washington, D.C.
) 20231, on
)
) December 22, 2000
) (Date)
)
) Douglas G. Muehlhauser, Reg. No. 42,018

AMENDMENT

Assistant Commissioner for Patents
 Washington, D.C. 20231

Dear Sir:

IN THE CLAIMS

Please add the following Claims:

15. A product browsing system comprising:

 a server computer having a network connection;
 a product database including first data representing a product, including second data representing a competing product, and including third data representing an association between said product and said competing product, said product database residing on a computer readable medium of the server computer; and

 a dynamic page file for generating an electronic store page, said dynamic page file including instructions to use said second data as a query parameter to obtain said first data from said product database, said first data included in said electronic store page, said electronic store page transmitted via said network connection.

16. A method for retrieving information about a product using information about another product, said method comprising:

 a step for storing information on a first set of products;

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a step for storing information on a second set of products;
a step for storing an association between the first set of products and the second set of products said association representing product equivalency;
a step for establishing communication between a client computer and a server computer;
a step for transmitting a product identifier from the first set of products to the server computer; and
a step for receiving a competing product identifier from the second set of products.

REMARKS

The following remarks are responsive to the August 25, 2000 Office Action (the "Office Action) for the above-referenced patent application.

Claims 1-14 are pending in the application. In the Office Action, the Examiner rejected Claims 1-13 as unpatentable under 35 U.S.C. § 103(a) over the Microsoft Computer Dictionary in view of Official Notice and rejected Claim 14 as unpatentable under 35 U.S.C. § 103(a) over the "Information Today article." For the reasons set out below, Applicant respectfully submits that the cited references do not render the pending claims unpatentable, and thus respectfully requests that the Examiner withdraw the rejections.

Response to Rejection of Claim 1

The Examiner rejected Claim 1 under 35 U.S.C. § 103 (a) as being unpatentable over the Microsoft Computer Dictionary ("MSC Dictionary") and in view of Official Notice.

In rejecting Claim 1, the Examiner relied on the definition of "relational database" in the MSC Dictionary and on Official Notice. Thus, the Examiner cited page 403 of the MSC Dictionary as teaching the product database recited in Claim 1 as follows:

a product database including first data representing a product, including second data representing a competing product, and including third data representing an association between said product and said competing product, said product database stored on a computer readable medium;

Applicant carefully reviewed the cited definition and found no teaching or suggestion of Applicant's product database, and in particular, for example, found no teaching of the recited "third data representing an association between a product and a competing product."

Additionally with respect to the recited product database, the Examiner observed that the MSC Dictionary "fails to teach the feature of a relational database based upon a comparison of competing products." The Examiner then took Official Notice that "the comparison feature between any two or more forms of data is old and well known" from conditional loops in the computer art. The Examiner's reliance on Official Notice is misplaced, however, as the language of Claim 1 does not include the term "comparison feature".

Applicant submits that the MSC Dictionary, considered alone or in combination with the Official Notice of conditional loops taken by the Examiner, does not teach or suggest the product database recited in Claim 1. Applicant hereby traverses the Examiner's assertion taken in the Official Notice. Additionally, Applicant hereby requests additional proof from the Examiner or an affidavit under 37 C.F.R. Section 1.104(d)(2) to support the Official Notice the Examiner believes renders obvious the product database recited in Claim 1.

In further regard to Claim 1, the Examiner relied on the definition of "dynamic page" in the MSC Dictionary as teaching a dynamic page file recited in Claim 1 as follows:

a dynamic page file for generating an electronic store page, said dynamic page file including instructions to use said second data as a query parameter to obtain said first data from said product database, said first data included in said electronic store page, said dynamic page file stored on said computer readable medium;

Applicant carefully reviewed the cited definition of dynamic page and found no teaching or suggestion of the dynamic page file as recited in Claim 1.

The Examiner stated that the MSC Dictionary "fails to explicitly teach the features of the second data used to query the first data from the product database." The Examiner then took Official Notice that "the selection feature is old and well known in the computer art in the form of a conditional loop, which is a type of query, with indexes or subscripts to represent any data in table or matrix form in the context of a programming language." Taking such Official Notice, the Examiner concluded that it would have been obvious to one of ordinary skill to "implement such a feature to gain the advantage of a more robust analysis of business or product data."

Applicant submits that the MSC Dictionary, whether considered alone or in combination with the subject matter of the Official Notice taken by the Examiner, does not teach the dynamic page file as recited in Claim 1. In particular, for example, the MSC Dictionary considered in view of the Official Notice of a conditional loop taken by the Examiner fails to teach or suggest a dynamic page file including instructions to use the recited second data as a query parameter to obtain the recited first data. Applicant hereby traverses the Examiner's assertion taken in the Official Notice. Additionally, Applicant requests additional proof from the Examiner or an affidavit under 37 C.F.R. Section 1.104(d)(2) to support the Official Notice the Examiner believes renders obvious the dynamic page file recited in Claim 1.

Importantly, even if the references cited by the Examiner taught each and every limitation of Claim 1 -- which they do not -- the Examiner has still failed to identify any suggestion or motivation in the prior art to combine the three MSC Dictionary definitions and the three Official Notices relied upon in the Office Action to reject Claim 1 under 35 U.S.C. § 103(a). It is well settled that a claim may not be rejected as obvious in view of a combination of references unless there is evidence that the prior art itself includes some suggestion or motivation to combine those references or those of ordinary skill knew to combine them. *In re Jones*, 958 F.2d 347 (Fed. Cir. 1988). Here, the Examiner provided no such evidence. Certainly, Applicants' patent application may not be used as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572 (Fed. Cir. 1984).

Also importantly, the Examiner has impermissibly used Applicants' claims as blueprints to search piecemeal through the prior art to attempt to reconstruct the subject matter of Applicants' claims. The U.S. Court of Appeals for the Federal Circuit has repeatedly rejected such attempts to use hindsight to show the obviousness of a patent claim. *In re Gorman*, 933 F.2d 982 (Fed. Cir. 1991) ("As in all determinations under 35 U.S.C. section 103, the decisionmaker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicants' structure as a template and selecting elements from references to fill the gaps."); *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985) (Recognizing that it is error to reconstruct the claimed invention from the prior art by using the claim as a blueprint).

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In this case, the Examiner did exactly what the Federal Circuit has prohibited. The Examiner picked through a computer dictionary, selecting one definition and then another and then another to reconstruct the claimed invention. Even that effort fell short, at which point the Examiner then took Official Notice after Official Notice after Official Notice to reconstruct Applicant's invention. Nothing could more clearly demonstrate that the Examiner simply used Claim 1 as a blueprint to pick and choose among isolated disclosures in the prior art. Applicant submits that the Examiner used improper hindsight to select the multiple definitions from the MSC Dictionary and to select the multiple Official Notices in order to reconstruct and reject Claim 1.

For at least the reasons stated above, Applicants submit that Claim 1 is patentably distinct from the cited prior art and respectfully requests that the Examiner withdraw the rejection of Claim 1.

Response to Rejection of Claims 2-6:

The Examiner rejected Claims 2-6 under 35 U.S.C. § 103 (a) as being unpatentable over the MSC Dictionary and in view of Official Notice.

With respect to dependent Claims 2-6, the Applicant submits that they are patentably distinct over the cited art for the same reason that Claim 1 is patentably distinct over the cited art. It is settled law that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, in rejecting Claim 2, the Examiner relied on the definition of "dynamic page" in the MSC Dictionary, as in Claim 1, and on Official Notice. Thus, the Examiner cited page 166 of the MSC Dictionary as teaching the dynamic page file recited in Claim 2 as follows:

A second dynamic page file for generating a second electronic store page,
said dynamic page file including second instructions to use information
identifying a manufacturer as a query parameter to obtain said second data
from said product database;

As indicated above, applicant carefully reviewed the cited definition of dynamic page. But Applicant found no teaching or suggestion of Applicants' recited second dynamic page file, and in particular, for example, found no teaching of the recited "second instructions to use information identifying a manufacturer as a query parameter to obtain said second data."

Additionally with respect to the recited second dynamic page file, the Examiner observed that the MSC Dictionary "fails to explicitly teach the specific details of generating a second electronic store page, with the dynamic page file including second instructions to identify a manufacturer as a query parameter database." The Examiner then took Official Notice that "the selection feature is old and well known in the computer art in the form of a conditional loop". But again, the Examiner's reliance on Official Notice is misplaced, because the language of Claim 2 does not include "select" or "selection".

The Examiner concluded that it would have been obvious to one of ordinary skill to "implement such a feature to gain the advantage of a more robust analysis of business or product data." Applicant submits that the MSC Dictionary, considered alone or in combination with the Official Notice of conditional loops taken by the Examiner, does not teach or suggest the second dynamic page file recited in Claim 2. Applicant hereby traverses the Examiner's assertion taken in the Official Notice. Additionally, Applicant hereby requests additional proof from the Examiner or an affidavit under 37 C.F.R. Section 1.104(d)(2) to support the Official Notice the Examiner believes renders obvious the dynamic page file recited in Claim 2.

As was true with respect to Claim 1, the Examiner again failed to identify any suggestion or motivation in the prior art to combine the MSC Dictionary definition and the Official Notice relied upon in the Office Action to reject Claim 2 under 35 U.S.C. § 103(a). Thus, because the cited references and Official Notices fail to teach or suggest the claimed subject matter, and further because no suggestion exists in the prior art to combine the cited definitions and the Official Notices, a rejection under section 103 is improper.

With respect to Claim 3, Applicant submits that, because Claim 3 depends from Claims 1 and 2, which are patentably distinct over the cited art, Claim 3 must also necessarily be patentably distinct. Thus, Applicant respectfully requests that the Examiner withdraw the rejection of Claim 3.

In rejecting Claim 4, the Examiner again turned to the MSC Dictionary and relied on the definition of "hyperlink" and on still further Official Notice. Thus, the Examiner cited page 240 of the MSC Dictionary as teaching the electronic store page recited in Claim 4 as follows:

An electronic store page having a hyperlink responsive to a customer selection of said hyperlink to generate said request;

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Applicant carefully reviewed the cited definition and found no teaching or suggestion of Applicant's electronic store page.

Additionally with respect to the recited electronic store page, the Examiner observed that the MSC Dictionary "fails to teach the feature of a request for a competitor's price." The Examiner then took Official Notice that "this feature is old and well known in the computer art". The Examiner's reliance on Official Notice is misplaced, however, as Claim 4 nowhere includes the term "competitor's price".

Applicant submits that the MSC Dictionary, considered alone or in combination with the Official Notice taken by the Examiner, does not teach or suggest the electronic store page recited in Claim 4. Applicant hereby traverses the Examiner's assertion taken in the Official Notice. Additionally, Applicant hereby requests additional proof from the Examiner or an affidavit under 37 C.F.R. Section 1.104(d)(2) to support the Official Notice the Examiner believes renders obvious the electronic store page recited in Claim 4.

As was true with respect to Claims 1-2, the Examiner again failed to identify any suggestion or motivation in the prior art to combine the MSC Dictionary definition and the Official Notice relied upon in the Office Action to reject Claim 4 under 35 U.S.C. § 103(a). Thus, because the cited references and Official Notices fail to teach or suggest the claimed subject matter, and further because no suggestion exists in the prior art to combine the cited definitions and the Official Notices, a rejection under section 103 is improper.

Also, just as the Examiner did with respect to Claim 1, the Examiner impermissibly used Applicants' Claims 2-3 and 4 as a blueprint to search piecemeal through the prior art to attempt to reconstruct the subject matter of those claims. Again, the Examiner simply used Claim 2 and Claim 4 as blueprints to pick and choose among isolated disclosures in the prior art to reconstruct and reject Claims 2 and 4. Such use of hindsight is improper.

With respect to Claims 5 and 6, Applicant submits that, because Claims 5 and 6 depend from Claims 1 and 4, which are patentably distinct over the cited art, Claims 5 and 6 must also necessarily be patentably distinct. Thus, Applicant respectfully requests that the Examiner withdraw the rejection of Claims 5 and 6.

For at least the reasons stated above, Applicant submits that Claims 2-6 are patentably distinct from the cited prior art and respectfully requests that the Examiner withdraw the rejection of Claims 2-6.

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Response to Rejection of Claim 7:

The Examiner rejected Claim 7 under 35 U.S.C. § 103 (a) as being unpatentable over the MSC Dictionary and in view of Official Notice.

As in Claims 1-6, the Examiner relied on a definition in the MSC Dictionary and on Official Notice in rejecting Claim 7. The Examiner cited the definition of "relational database" in page 403 of the MSC Dictionary as teaching a method recited in Claim 7 as follows:

transmitting with a page server at least one corresponding product hyperlink to a customer browser, said at least one corresponding product hyperlink operatively associated with a corresponding product identifier representing a corresponding product and operatively associated with a page file identifier representing a corresponding product page file;

Applicant carefully reviewed the cited definition and found no teaching or suggestion of Applicant's method, and in particular, for example, found no teaching of the recited "product hyperlink operatively associated with a corresponding product identifier representing a corresponding product and operatively associated with a page file identifier representing a corresponding product page file."

Additionally with respect to the recited method, the Examiner observed that the MSC Dictionary "fails to teach the feature of a relational database based upon a product identifier and the associated page identifier of a corresponding product." The Examiner then took Official Notice that "the corresponding feature between any two or more forms of data is old and well known" in the form of conditional loops in the computer art. The Examiner's reliance on Official Notice is misplaced, however, because the Examiner ignored the specific association and the specific subject matter recited in Claim 7.

Applicant submits that the MSC Dictionary, considered alone or in combination with the Official Notice of conditional loops taken by the Examiner, does not teach or suggest the method recited in Claim 7. Applicant hereby traverses the Examiner's assertion taken in the Official Notice. Additionally, Applicant hereby requests additional proof from the Examiner or an affidavit under 37 C.F.R. Section 1.104(d)(2) to support the Official Notice the Examiner believes renders obvious the method recited in Claim 7.

In further regard to Claim 7, the Examiner relied on the definition of "web browser" and "tag" in the MSC Dictionary as teaching a displaying method recited in Claim 7 as follows:

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Notice. Additionally, Applicant hereby requests additional proof from the Examiner or an affidavit under 37 C.F.R. Section 1.104(d)(2) to support the Official Notice the Examiner believes renders obvious the method recited in Claim 7.

In further regard to Claim 7, the Examiner relied on the definition of "web browser" and "tag" in the MSC Dictionary as teaching a displaying method recited in Claim 7 as follows:

Displaying with said customer browser information identifying a product, a portion of said displayed information selectable to activate said corresponding product hyperlink;

Applicant carefully reviewed the cited definition of web browser and tag and found no teaching or suggestion of the method as recited in Claim 7.

The Examiner stated that the MSC Dictionary "fails to explicitly teach the features of selecting a corresponding product hyperlink." The Examiner then took Official Notice that "this feature is old and well known in the computer art as in constructing relational databases with Microsoft Access." Taking such Official Notice, the Examiner concluded that it would have been obvious to one of ordinary skill to "implement such a feature to gain the advantage of a more informed purchase decision."

Applicant submits that the MSC Dictionary, whether considered alone or in combination with the subject matter of the Official Notice taken by the Examiner, does not teach the method as recited in Claim 7. In particular, for example, the MSC Dictionary considered in view of the Official Notice of constructing relational databases taken by the Examiner fails to teach or suggest a method of "displaying with said customer browser information identifying a product, a portion of said displayed information selectable to activate said corresponding product hyperlink." Applicant hereby traverses the Examiner's assertion taken in the Official Notice. Additionally, Applicant requests additional proof from the Examiner or an affidavit under 37 C.F.R. Section 1.104(d)(2) to support the Official Notice the Examiner believes renders obvious the method recited in Claim 7.

As was true with respect to Claim 1-6, the Examiner again failed to identify any suggestion or motivation in the prior art to combine the MSC Dictionary definitions and the Official Notices relied upon in the Office Action to reject Claim 7 under 35 U.S.C. § 103(a). Thus, because the cited references and Official Notices fail to teach or suggest the claimed

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For at least the reasons stated above, Applicants submit that Claim 7 is patentably distinct from the cited prior art and respectfully requests that the Examiner withdraw the rejection of Claim 7.

Response to Rejection of Claims 8-10:

The Examiner rejected Claims 8-10 under 35 U.S.C. § 103 (a) as being unpatentable over the Dictionary and in view of Official Notice.

With respect to dependent Claims 8-10, the Applicant submits that they are patentably distinct over the cited art for at least the same reasons that the Claim 7 is patentably distinct over the cited art. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Again, as in Claims 1-7, the Examiner relied on the definition in the MSC Dictionary, and on Official Notice, in rejecting Claim 8. The Examiner cited the definition of "server" in page 430 of the MSC Dictionary as teaching the method recited in Claim 8 as follows:

Processing instructions in said page file to use said identifier to obtain data representing a corresponding product;

Applicant carefully reviewed the cited definition and found no teaching or suggestion of any act recited in Applicant's method.

Additionally with respect to the recited method, the Examiner observed that the MSC Dictionary "fails to teach the feature of processing instructions using the product identifier to represent a corresponding product." The Examiner then took Official Notice that "these features, taken separately, are old and well known in the computer business art in the COBOL programming language." Thereafter, the Examiner concluded that it would have been obvious to one of ordinary skill to "combine such features to gain the advantage of a more informed buying decision."

Applicant respectfully disagrees with the Examiner's conclusion that it would have been obvious to one of ordinary skill to combine the cited features to arrive at Applicant's invention.

Firstly, the Examiner stated that it would have been obvious to one of ordinary skill to combine a "server" and "a feature of processing instructions using the product identifier to represent a corresponding product." This rationale merely suggests that one of ordinary skill in the art would have the capabilities to arrive at the invention. That rationale has been rejected by

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the courts. *Ex parte Levengood*, 28 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). ("At best, the Examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at appellant's invention because he had the necessary skills to carry out the requisite steps. This is an inappropriate standard for obviousness... That which is within the capabilities of one skilled in the art is not synonymous with obviousness...").

Secondly, the Examiner's conclusion that it would have been obvious to one of ordinary skill to combine a "server" and "a feature of processing instructions using the product identifier to represent a corresponding product" is misplaced as Applicant recited a "method of locating information about a product using information about a corresponding product, said method comprising the step of ... processing instructions in said page file to use said identifier to obtain data representing a corresponding product." Claims 8-10 are directed to methods including specific acts not to a general server structure defined apart from any specific acts. Therefore the Examiner's rejections at least partly based upon a "server" is inappropriate.

Additionally, as in Claim 1-7, the Examiner again failed to identify any suggestion or motivation in the prior art to combine those features the Examiner has admitted "taken separately" are old and well known. Thus, because the cited references and Official Notices fail to teach or suggest the claimed subject matter, and further because no suggestion exists in the prior art to combine the cited definitions and the Official Notices, a rejection under section 103 is improper.

Applicant submits that the MSC Dictionary, considered alone or in combination with the Official Notice taken by the Examiner, does not teach or suggest the method recited in Claim 8. Applicant hereby traverses the Examiner's assertion taken in the Official Notice. Additionally, Applicant hereby requests additional proof from the Examiner or an affidavit under 37 C.F.R. Section 1.104(d)(2) to support the Official Notice the Examiner believes renders obvious the method recited in Claim 8.

Also, just as the Examiner did with respect to Claim 7, the Examiner impermissibly used Applicant's Claim 8 as a blueprint to search piecemeal through the prior art to attempt to reconstruct the subject matter of that claim. Thus, because the Examiner impermissibly relied on hindsight and also for the reasons stated above, Applicant respectfully requests that the Examiner withdraw the rejection of Claim 8.

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With respect to Claim 9, Applicant submits that, because Claim 9 depends from Claims 7 and 8, which are patentably distinct over the cited art, Claim 9 must also necessarily be patentably distinct. Thus, Applicant respectfully requests that the Examiner withdraw the rejection of Claim 9.

For at least the reasons stated above, Applicant submits that Claims 8-10 are patentably distinct from the cited prior art and respectfully requests that the Examiner withdraw the rejection of Claims 8-10.

Response to Rejection of Claim 11:

The Examiner rejected Claim 11 under 35 U.S.C. § 103 (a) as being unpatentable over the MSC Dictionary and in view of Official Notice.

As in Claims 1-10, the Examiner relied on the definitions in the MSC Dictionary and on Official Notice. The Examiner cited pages 95, 96, 166, 240, 392, 422-423, 424-425, 431, 449 of the MSC Dictionary and various Official Notices as teaching an e-store dynamic page file as recited in Claim 11.

Applicant carefully reviewed each of the cited definitions and the Official Notices. Applicant submits that the MSC Dictionary pages, considered alone or in combination with the Official Notices taken by the Examiner, do not teach or suggest the e-store dynamic page file recited in Claim 11. Applicant hereby traverses the Examiner's assertion taken in the Official Notice. Additionally, Applicant hereby requests additional proof from the Examiner or an affidavit under 37 C.F.R. Section 1.104(d)(2) to support the Official Notice the Examiner believes renders obvious the script component recited in Claim 11.

As in the rejections of Claims 1-10, the Examiner has failed to cite any reference that teaches each and every limitation of Claim 11. Also as in Claims 1-10, the Examiner has failed to identify any suggestion or motivation in the prior art to combine the nine MSC Dictionary definitions and the four Official Notices relied upon in the Office Action to reject Claim 11 under 35 U.S.C. § 103(a). Thus, because the cited references and Official Notices fail to teach or suggest the claimed subject matter, and further because no suggestion exists in the prior art to combine the cited definitions and the Official Notices, a rejection under section 103 is improper.

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Also, just as the Examiner did with respect to Claim 1-10, the Examiner, in hindsight, impermissibly used Applicants' Claim 11 as a blueprint to search piecemeal through the prior art to attempt to reconstruct the subject matter of that claim.

For at least the reasons stated above, Applicants submit that Claim 11 is patentably distinct from the cited prior art and respectfully requests that the Examiner withdraw the rejection of Claim 11.

Response to Rejection of Claims 12-13:

The Examiner rejected Claims 12-13 under 35 U.S.C. § 103 (a) as being unpatentable over the MSC Dictionary and in view of Official Notice.

With respect to dependent Claims 12-13, the Applicant submits that they are patentably distinct over the cited art for the same reason that the Claim 11 is patentably distinct over the cited art. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

As was true with respect to Claims 1-11, the Examiner has failed to identify any reference which teaches or suggests the claimed subject matter of Claims 12-13. Also as in Claims 1-11, none of the cited references contain suggestions or motivation to combine the cited definitions and Official Notices.

For at least the reasons stated above, Applicant submits that Claims 12-13 are patentably distinct from the cited prior art and respectfully requests that the Examiner withdraw the rejection of Claims 12-13.

Response to Rejection of Claim 14:

The Examiner rejected Claim 14 under 35 U.S.C. § 103 (a) as unpatentable over the *Information Today* article.

In rejecting Claim 14, the Examiner relied on the *Information Today* article ("Article") to conclude that a system for locating information about products comprising associating means, requesting means, query means, information assembly means, transmitting means is obvious.

A review of the cited reference shows no teachings or a suggestion of Applicants' system for locating information about products comprising associating means, requesting means, query means, information assembly means, transmitting means. The Article teaches a system wherein

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users can search, select, and sort products based on different given categories such as brand names, product types, and price. In contrast, Applicant claims a system for locating information about products comprising an associating means for storing an association between a product and a corresponding product. This associating means is not taught, suggested or obvious from anything in the Article.

Furthermore, the Article is at best, "an invitation to explore a new technology and is not at all specific as to the particular form of the claimed invention and how to achieve it. Such a suggestion may make an approach 'obvious to try' but it does not make the invention obvious." *Ex parte Obukowicz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1992), citing *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988).

As in Claims 1-13, the Examiner has failed to articulate a *prima facie* case of obviousness. In order to articulate a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347 (Fed. Cir. 1988). In the present case, the cited art fails to teach or suggest or motivate combining or modifying the teachings to produce the claimed invention.

Moreover, an Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention. *ACS Hosp. Sys. Inc. v. Montefiore Hosp.*, 732 F.2d 1572 (Fed. Cir. 1984).

In any obviousness rejection, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136 (Fed. Cir. 1986). The Examiner has relied on impermissible hindsight in concluding Claim 14 is obvious.

For at least the reasons stated above, Applicant submits that Claim 14 is patentably distinct from the cited prior art and respectfully requests that the Examiner withdraw the rejection of Claim 14.

CONCLUSION

For the reasons stated above, Applicant submits that all the pending claims, including new Claims 15 and 16 are patentably distinct over the cited prior art and thus are in condition for

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allowance. Applicant respectfully requests that the Examiner withdraw the rejections of the Claims 1-14, allow those and new Claims 15-16, and pass the present application to issuance. If there is any further impediment, the Examiner is respectfully invited to call the attorney of record at (949) 721-2994 or the number provided below.

Please charge any additional fees, including any fees for additional extension of time, or credit any overpayment to Deposit Account No. 11-1410. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 12/16/98

By: 

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